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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,435	12/31/2001	David M. Read	55290US002	4823

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EXAMINER	
ALEXANDER, LYLE	
ART UNIT	**PAPER NUMBER**
1743	

DATE MAILED: 12/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/037,435	READ, DAVID M.	
	Examiner	Art Unit	
	Lyle A. Alexander	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 September 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27 and 38-58* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27 and 38-58* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/15/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-27 and 38-58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,790,411. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed to a hydrogen peroxide indicator and method of use using the same indicator compositions. However, the instant claims now require a salt of a transition metal. In the absence of a showing of unexpected results, because the same results are achieved from the indicator alone or with the salt of a transition metal, one having ordinary skill in the art would have expected the newly claimed salt to be non-essential to achieve the reaction and thus within the skill of the art as a result effective variable (In re Boesch (205 USPQ 215)).

Claims 1-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/890,612. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed to the same composition for hydrogen peroxide detection. However, the instant claims now require a salt of a transition metal. In the absence of a showing of unexpected results, because the same results are achieved from the indicator alone or with the salt of a transition metal, one having ordinary skill in the art would have expected the newly claimed salt to be non-essential to achieve the reaction and thus within the skill of the art as a result effective variable (In re Boesch (205 USPQ 215)).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

he following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-27 and 38-58 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Barrett (USP 5,955,025).

Barrett teach a colorimetric composition placed on a binder/support that indicating hydrogen peroxide. The composition includes copper diazo dyes that have

been read on the claimed diazo colorant combined with a copper salt. See the specification as well as claims 4,16,20 or 25 for the teaching of the copper diazo dye.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel.

See the appropriate paragraph of the 6/17/05 Office action.

Patel is silent to the addition of a copper salt.

In the absence of a showing of unexpected results, because the same results are achieved from the indicator alone or with the copper salt, one having ordinary skill in the art would have expected the newly claimed salt to be non-essential ingredient because indistinguishable result are achieved from Patel and the instant claims. The addition of

a copper salt would have been a result effective variable to achieve the expected results of buffering (In re Boesch (205 USPQ 215)).

Claims 1-27 and 38-58 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kirkof et al. (USP 6,488,890), WO 98/58683 or Amhof et al.(USP 6,238,623).

See the appropriate paragraph of the 6/17/05 Office action.

Kirkof et al. (USP 6,488,890), WO 98/58683 and Amhof et al.(USP 6,238,623) are silent to the addition of a copper salt.

In the absence of a showing of unexpected results, because the same results are achieved from the indicator alone or with the copper salt, one having ordinary skill in the art would have expected the newly claimed salt to be non-essential ingredient because indistinguishable result are achieved by Kirkof et al. (USP 6,488,890), WO 98/58683 or Amhof et al.(USP 6,238,623) and the instant claims. The addition of a copper salt would have been a result effective variable to achieve the expected results of buffering (In re Boesch (205 USPQ 215)).

Response to Arguments

Applicant's arguments filed 9/15/05 have been fully considered but they are not persuasive.

Applicant's election with traverse of group I in the reply filed on 9/15/05 is acknowledged.

Applicants' traverse the restriction requirement on the basis that consideration of the claims separately would require duplication of work. Thus there would not be an undue burden to examine all of the claims together. The Office notes the invention were shown to be independent and distinct and have been properly restricted. The requirement is still deemed proper and is therefore made FINAL.

Applicant traverses the judicially created doctrine of obviousness-type double patenting and provisional rejections of record on the basis these references do not claim at least one salt of a transition metal. The Office acknowledges these latest amendments but maintains that because an indistinguishable type of indication (e.g. the identical indication of hydrogen peroxide vapors) occurs with the same indicators, the newly claimed metals are not critical and would have been within the skill of the art as design choice.

Applicant's amendments to clarify the 35 USC 112 second paragraph issues are appreciated and have obviated these rejections.

Applicant's state the cited prior art has been overcome by the instant amendments that now specify an indicator composition with at least one salt of a transition metal with the colorant. The Office has changed the 35 USC 102 rejections of 6/17/05 to 35 USC 103 rejections maintaining the cited prior art uses the same indicators to achieve the same result (e.g. indication of hydrogen perioxide) and the selection of the claimed salt would have been within the skill of the art.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lyle A Alexander
Primary Examiner
Art Unit 1743